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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/691,364

10/18/2000

Thomas N Berarducci

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PATENT LEGAL STAFF
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EXAMINER

REITZ, KARL

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 05/27/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/691,364

Applicant(s)

BERARDUCCI ET AL.

Examiner

Karl R. Reitz

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2000.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-11 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 18 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Drawings

2. New corrected drawings are required in this application because many of the reference characters, labels, and flow arrows are difficult to read. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

3. The drawings are objected to because figures, which are presumably 1, 3 and 4, are not labeled as figures 1, 3 and 4. Further, reference numeral 52 is used to refer to "production controller" in figure 1, but is referred to as the "album production controller" on page 5 line 21 of the specification. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 80 (page 16 line 16). A proposed drawing correction or corrected drawings

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are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota (6,324,521) in view of Gerson (5,721,826).

7. In accordance with claims 1 and 8, Shiota discloses a method of selecting images from a plurality of images previously stored in a memory location, ordering services to be provided utilizing the images, and transferring the images to a remote memory location over a changer where the services are provided; in Shiota's system, a customer 1 takes images to a lab 14, who digitizes the images and stores them on a server 15 (col. 7 lines 6-10), the customer then requests services on the images by accessing the images via the web (col. 7 lines 15-18) and the images are printed at the site of the server 15 or transferred to another lab that can print the images (col. 8 line 62 – col. 9 line 5).

8. Shiota further discloses establishing a service account with the service provider and furnishing a user with an identifier for such service account to permit a user to have access to ordered services; in Shiota's system, a user is given a password, which is used to access their account and order services on their images (col. 8 lines 12-16).

9. Shiota further discloses storing a plurality of images in the memory location 15 (col. 7 lines 6-10) along with corresponding thumbnail images or lower resolution images (col. 8 lines 23-30).

10. Shiota further discloses displaying the thumbnail images to the user (col. 8 lines 23-30).

11. Shiota further discloses the user selecting images to be processed and transferred by viewing the thumbnail images (col. 8 lines 23-30).

12. Shiota further discloses providing image identifiers for each selected image to be uploaded to the remote location and a service order which specifies the services to be provided; in Shiota's system, figure 2 displays the order information that is transmitted to the service center by the customer, it includes an image identifier (reception number) and the services to be provided (size, number of prints, etc.) (col. 8 lines 31-39).

13. Shiota further discloses transferring the images to the remote location at a suitable time for effective data transfer; in Shiota's system, the remote site is given the location of the image data and subsequently downloads it when it is ready for processing (col. 9 lines 1-5).

14. However, Shiota does not disclose the remote location confirming the receipt of the service order.

15. Gerson discloses the remote location confirming receipt of the service order; in Gerson's system, the remote location, when it has been confirmed that receipt is successful, generates a signal to create a "transfer confirmation document 116" on the user's site (col. 7 lines 48-53).

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16. Shiota and Gerson are combinable because they are from the same field of endeavor, namely remotely transferring image data.

17. Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art, to provide a confirmation of image transmission to the user, as disclosed by Gerson.

18. The motivation for doing so would have been to a) let the user know that data has been properly received, so that the user does not feel the need to re-transmit data and b) provide the user with a complete transaction record, for their files (Gerson: col. 3 lines 50-54).

19. In accordance with claim 2, Shiota discloses that the service provided may be an album (col. 4 lines 39-40).

20. In accordance with claim 3, Shiota discloses that the services provided are selected from prints having a plurality of print sizes (col. 8 lines 33-37).

21. In accordance with claim 4, Shiota discloses that the customer is charged for services electronically, obviously this would include charging a credit card or bank account, etc. (col. 4 lines 25-27).

22. In accordance with claims 9 and 10, Shiota discloses completing the ordered services and sending the images for which ordered services have been provided to a third party using electronic mail (col. 8 lines 30-31).

23. In accordance with claim 11, Shiota discloses sending completed prints by the mail (col. 4 lines 51-54).

24. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota in view of Gerson in further view of Slivka (6,256,668).

25. In accordance with claims 5-7, Shiota and Gerson do not disclose allowing the user to select the time for transfer, that the time is selected for efficient transfer, or that the time is selected from a plurality of service times provided by the provider.

26. Slivka discloses allowing the user to select the time for transfer, either immediate or delayed for efficiency (col. 9 lines 8-12).

27. Shiota, Gerson and Slivka are combinable because they are from the same field of endeavor, namely remotely transferring data.

28. Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art, to allow the user to select the time for transfer, select time for transfer so that it is efficient, or select time from a plurality of service times provided by the provider for efficiency, as disclosed by Slivka.

29. The motivation for doing so would have been to allow the user to continue using their computer without slowing down the computer with the data transfer, which can then be performed at a later more convenient time.

Conclusion

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The remaining prior art made of record relate to systems which allow users to transmit image data from their homes or businesses directly to a processing lab, which prints the selected images according to the selected options, bills the user and mails the prints back to the user.

Contact Information

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl R. Reitz whose telephone number is (703) 305-8696. The examiner can normally be reached on Monday-Friday 8:00-4:30.

32. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (703) 305-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

33. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KRR

David K Moore

DAVID MOORE
SUPERVISOR
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